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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,630

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Paul Lapstun

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

COLBERT, ELLA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,630	<b>Applicant(s)</b> LAPSTUN ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) 12-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 35-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-44 are pending. Group I, claims 1-11 and 35-44 have been elected without traverse and claims 12-34 have been withdrawn in Response to the Election/Restriction and Request for Extension of Time filed 1/01/08. Claims 1-11 and 35-44 will be examined on the merits.
2. Claims 1, 8, and 35 have been amended.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 6, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,080,364) Seidman.

Claims 1 and 41. Seidman discloses, A method of providing anonymous entry to a competition via a printed competition entry form that includes machine-readable coded data, the method including the steps, performed in a computer system, of: receiving interaction data representing interaction of a sensing device with the coded data, the interaction data enabling the competition entry to be electronically captured in the computer system (col. 2, lines 1-7); assigning a competition alias identifier (ID) to the competition entry (col. 2, lines 7-10); and transmitting the competition entry to a competition administrator with the competition alias ID, thereby enabling the anonymous entry to the competition (col. 2, line 45-col. 3, line 12 and col. 4, lines 10-38).

Seidman further discloses claim 41 as set forth above in claim 1.

Claim 2. Seidman discloses, The method of claim 1, wherein the form is disposed on a product label including human-readable information relating to the competition, and the coded data is indicative of at least an identity of the label, wherein the interaction data includes at least the identity of the label (col. 4, lines 39-61).

Claim 3. Seidman discloses, The method of claim 2, wherein at least some of the coded data includes a label identifier (col. 3, lines 32-40).

Claim 4. Seidman discloses, The method of claim 3, wherein the label identifier is a unique product item identifier col. 8, lines 40-43).

Claim 5. Seidman discloses, The method of claim 4, wherein the unique product item identifier is an electronic product code (col. 8, lines 55-col. 9, line 18).

Claim 6. Seidman discloses, The method of claim 5, wherein the coded data is substantially invisible to a human. (fig. 2). The bar-coded data is understood to be substantially invisible to a human because though a barcode may be recognizable as a series of the lines the data contained therein is not readily observable by a human.

Claim 41. Seidman discloses, A method according to claim 1, for providing; anonymous electronic redemption of a coupon printed as part of a product label, the product label including machine-readable coded data, the method including the steps, performed in a computer system, of: receiving interaction data representing interaction of a sensing device with the coded data, the coupon data of the coupon and a product identifier associated with the product label being electronically captured using the interaction data; and assigning a competition alias identifier ID to the coupon data (col. 2, lines 1-

10; and transmitting the coupon data, the product identifier and the competition alias ID to a coupon administrator configured to redeem the coupon electronically (col. 2, line 45-col. 3, line 12 and col. 4, lines 10-38).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-11, 35-40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,080,364) Seidman in view of (US 5,978,773) Hudetz et al, hereafter Hudetz.

Claim 7. Seidman failed to disclose, The method of claim 1, wherein the interaction data but is silent regarding includes digital ink, the digital ink having been generated by the sensing device in response to movement of the sensing device relative to the entry form, the method including the step of transmitting the digital ink to the competition administrator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use digital ink being generated by a sensing device in response to movement of the sensing device relative to the entry form because this would represent the mere known reward system through conventional means that would yield expected and predictable results.

Claim 8. Seidman discloses, The method of claim 1, wherein the interaction data includes a device identifier (ID) associated with the sensing device used to generate the

interaction data, and the step of assigning the competition alias ID is performed in reliance on at least the device ID (col. 5, lines 14-48).

Claim 9. Seidman discloses, The method of claim 8, wherein the competition alias ID is selected or calculated so as to be unique to a combination of the device ID and a competition identity (col. 6, line 55-col. 7, line 26).

Claim 10. Seidman discloses, The method of claim 1, wherein the competition alias ID is selected or calculated so as to be unique to a combination of the device ID and a manufacturer, producer or other entity associated with the product (col. 6, line 55-col. 7, line 26).

Claim 11. Seidman discloses, The method of claim 1, wherein the competition alias ID is selected or calculated so as to be unique to a combination of the device ID and a competition entry (col. 8, lines 25-54).

Claim 35. Seidman discloses, A method according to claim 1, for providing entry to a competition via machine-readable coded data on an entry form on a printed label of a product, the method including the steps of:

receiving, in a computer system, interaction data from a sensing device, the interaction data representing interaction of the sensing device with the coded data on the entry form, the competition entry being electronically captured in the computer system, by using the interaction data (col. 2, lines 1-7); and transmitting the competition entry to a competition administrator (col. 2, line 45-col. 3, line 12).

Claim 36. Seidman discloses, A method according to claim 1, using a product label for providing entry to a competition, the product label comprising:

machine-readable coded data indicative of at least an identity of the label, said machine-readable coded data being readable by a sensing device as the sensing device is moved across the product label, thereby to produce interaction data for competition entry (col. 4, lines 39-61); human-readable information pertaining to the competition, the human-readable information being at least partially coincident with the machine-readable coded data, the human-readable information including at least one field element that has a corresponding zone defined in relation to it in a page description stored in a remote computer system (col. 8, lines 25-54).

Claim 37. seidman discloses, method according to claim 1, for anonymous entry to a competition, the competition being entered by interaction of a sensing device with a product label to generate interaction data indicative of at least an intention to enter the competition, the method including the steps, performed in a computer system, of: identifying a first telecommunication address of the entrant from either an identity of the sensing device received or determined in the computer system or the interaction data (Col. 6, lines 16-54); associating a temporary telecommunication address with the first telecommunication address (col. 7, lines 27-60) and sending the temporary telecommunication address and interaction data to a competition administrator (col. 7, line 61-col. 8, line 24). Seidman failed to disclose, receiving, from the competition administrator, information from the competition administrator addressed to said temporary telecommunication address; and forwarding the information from the competition administrator to the first telecommunication address and sending the temporary telecommunication address.

Hudetz discloses, receiving, from the competition administrator, information from the competition administrator addressed to said temporary telecommunication address (col. 7, lines 1-28); and forwarding the information from the competition administrator to the first telecommunication address (col. 10, lines 21-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hudetz in Seidman because such an incorporation would allow Seidman to have the address (URLs) of the Cyberspace sites of these locations assigned by the on-line service providers with navigation among these locations handled by proprietary client software, which runs on a user's personal computer.

Claim 38. Seidman discloses, A method according to claim 1, for competition entry by an entrant and limitation of subsequent communication between a competition administrator and the entrant via a sensing device interacting with machine-readable coded data on a printed competition entry form, the method comprising the steps, performed in a computer system, of: (a) receiving interaction data representing the interaction of the sensing device with the coded data, the competition entry being electronically captured in the computer system by using the interaction data (col. 7, lines 27-60); and (b) transmitting the competition entry to the competition administrator (col. 7, lines 54-60). Seidman failed to disclose, predetermined number of electronic messages from the competition administrator to the entrant. Hudetz discloses, , predetermined number of electronic messages from the competition administrator to the entrant (col. 11, line 61-col. 12, line 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings



of Hudetz in Seidman because such an incorporation would allow Seidman to keep the entrant in the competition informed as to the submitted entry and whether it is a winning entry.

Claim 39. Seidman failed to disclose, A method according to claim 1, for limiting communication between an application and a user, via a sensing device interacting with machine-readable coded data printed on a surface, the method comprising the steps, performed in a computer system, of: (a) receiving interaction data representing the interaction of the sensing device with the coded data, the interaction data enabling identification of the application; (b) transmitting information based on at least some of the interaction data to the application; and (c) configuring the computer system to transmit up to a predetermined number of electronic messages from the application to the user. Hudetz discloses, A method according to claim 1, for limiting communication between an application and a user, via a sensing device interacting with machine-readable coded data printed on a surface, the method comprising the steps, performed in a computer system, of: (a) receiving interaction data representing the interaction of the sensing device with the coded data, the interaction data enabling identification of the application (col. 11, lines 1-20); (b) transmitting information based on at least some of the interaction data to the application (col. 21-39); and (c) configuring the computer system to transmit up to a predetermined number of electronic messages from the application to the user (col. 11, line 61-col. 12, line 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hudetz in Seidman because such an incorporation would allow Seidman to

have the bar code indicia placed near human readable information since the bar code contains the remote server's numerical address in machine readable form.

Claim 40. Seidman discloses, A method according to claim 1, for instant win competition entry by an entrant via a printed competition entry form that includes machine-readable coded data that can be sensed by a sensing device configured to generate interaction data based on the sensed coded data, the method comprising the steps, performed in a computer system, of: receiving the interaction data representing interaction of the sensing device with the coded data, the competition entry being captured in the computer system by using the interaction data (col. 5, lines 26-48); transmitting the competition entry to a competition administrator that is configured to determine whether the competition entry is an instant win entry (col. 5, lines 31-48 and Fig. 2).

Claim 42. Seidman discloses, A method according to claim 1, for providing anonymous and electronic redemption a plurality of coupons, wherein each the plurality of coupons is disposed on a product label and includes coded data that can be used to determine a unique product identifier of the product label with which it is associated, the method including the steps of: using a sensing device, and for each of the plurality of coupons (col. 5, lines 26-48): (a) generating interaction data by sensing at least some of the coded data of the coupon, the interaction data representing interaction of the sensing device with the coded data (col. 5, lines 26-48); and (b) forwarding the interaction data to a computer system, for electronic capture of. the coupon offer and the product identifier associated with the product label in the computer system, for transmission of

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the coupon offer and the product identifier to a coupon administrator by the computer system (col. 5, line 49-col. 6, line 16) and receiving coupon redemption information from the coupon administrator after a predetermined combination of coupon offers relating to a plurality of the product identifiers and or coupon offers has been transmitted to the coupon administrator (col. 6, line 55-col. 7, line 26).

Claim 43. Seidman discloses, A method according to claim 1, for providing entry to a competition using a printed competition entry form including coded data readable by a sensing device as the sensing device is used to interact with the entry form, the method including the steps, performed in a computer system, of: receiving, from the sensing device, the product identifier and interaction data representing interaction of the sensing device with the coded data, the interaction data including at least the unique product identifier, a competition entry being electronically captured in the computer system by using the interaction data and a sensing device identifier ID of the sensing device (col. 7, lines 27-60). Seidman failed to disclose, allocating a temporary registration to the sensing device ID or to a user of the sensing device, the registration including a return electronic address associated with the sensing device ID or the user; and transmitting the competition entry to a competition administrator. Hudetz discloses, allocating a temporary registration to the sensing device ID or to a user of the sensing device, the registration including a return electronic address associated with the sensing device ID or the user; and transmitting the competition entry to a competition administrator (col. 9, line 23-col. 10, line 54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hudetz in

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Seidman because such an incorporation would allow Seidman to have the bar code indicia placed near human readable information since the bar code contains the remote server's numerical address in machine readable form.

Seidman and Hudetz failed to disclose, verifying competition entry via the return electronic address. It would have been obvious to verify the competition entry via return electronic address by one having ordinary skill in the art at the time the invention was made because when an entry is submitted electronically, the entrant wants to know that the entry was received to make sure the entrant qualifies for the drawing and meets the deadline for entry.

Claim 44. Seidman discloses, A method according to claim 1, for validating entry to a competition via interaction of a sensing device with a printed competition entry form comprising coded data indicative of a unique product identifier, the method comprising the steps, performed in the computer system, of: receiving, from the sensing device, the product identifier and interaction data representing interaction of the sensing device with the coded data, the interaction data including at least the unique product identifier a competition entry being electronically captured in the computer system by using the interaction data (col. 7, lines 27-60) and transmitting the product identifier and the competition entry to a competition administrator for validation of the competition entry at the competition administrator by verification of the product identifier (col. 8, line 25-col. 9, line 18). Note: The transmitting claim limitation is manually performed in Seidman..

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lieberman (US 5,855,369) disclosed conducting a prize drawing game of chance.

Eggleston et al (US 7,054,830) disclosed incentive programs and award fulfillment.

Scroggie et al (US 6,014,634) disclosed incentives to customers through a computer network.

Clapper, Jr. (US 6,056,289) disclosed a voucher and game ticket combination.

Philyaw (US 2005/0004981) disclosed conducting a contest using a network.

Muller et al (US 4,832,341) disclosed instant lottery using bar codes.

Behm et al (US 6,875,105) disclosed lottery ticket validation.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

March 30, 2008